Docket AUS920030649US1

<div align="right">Appl. No.: 10/697,864
Filed: 10/30/2003</div>

REMARKS

Rejections based on non-statuory subject matter

Claims 1-16

Claims 1-16 stand rejected under 35 U.S.C. 101 on grounds that the claims are directed to non-statutory subject matter. Specifically, the Office action, citing State Street, 149 F.3d at 1373-74 USPQ2d at 1601-02, contends that the claims are not directed to a final result that is useful, tangible and concrete. The Office action requests that Applicant include aspects in all claims relating to a practical application and final result that is concrete, useful and tangible.

Applicant respectfully disagrees. In particular, Applicant submits that the claims as originally submitted do set out a result that is concrete, useful and tangible, as explained herein below. In addition, however, Applicant herein amends claims 1 and 8 in a manner suggested by Primary Examiner Mizrahi, in the interest of an expedited allowance of the application. Attorney England wishes to thank Examiner Mizrahi for her helpful suggestion.

As stated in the present application, a problem exists in the prior art with respect to executing computer applications, as particularly described with regard to Java applications as follows:

> In the case of standalone application, failure to properly specify the correct JRE path explicitly will prompt the application to search for a JRE from the directories specified in the PATH variable. The application will execute within the first JRE that it finds as it proceeds through the directories specified in the PATH variable. If the first-found JRE is incompatible, the application will fail to execute as intended even though a compatible JRE may exist in another PATH directory (i.e., a path directory that has not been searched yet). In the case of the network application invoked via Web Start, the Web Start will try to automatically download the appropriate JRE from the vendor's web site to the system if the desired JRE is not specified. Casual users of Java® may find it difficult to determine an appropriate JRE on a system having multiple JREs. The present invention, as set forth below, addresses these drawbacks of conventional Java® implementations by describing a system and method that select the most appropriate JRE for any given application without user interaction.

Present application, page 3, lines 19-31.

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The present invention provides a concrete, tangible solution to this problem, described in the specification as follows:

> By employing the parser and the search engine, the invention beneficially ensures that applications will either execute in the most appropriate environment or alert the user that no compatible execution environment could be found. The invention improves on a conventional system in which the first-detected execution environment is used to execute an application even if that environment is sub-optimal or incompatible with the environment for which the application was originally intended.

Present application, page 5, lines 26-31. The beneficial result of the solution is further described in the specification as follows:

> By providing a mechanism for automated detection of the best available JRE and notification to the user when no compatible JRE can be found, the present invention addresses a potentially significant and widespread shortcoming of conventionally enabled Java®-based systems. Using a list of compatible JREs provides flexibility and control to the application developer, who can now specify exactly which JRE(s) are required to execute.

Present application, page 11, lines 24-28. Furthermore, claim 1 of the present application explicitly states that the method includes "selecting a compatible execution environment" and "executing the application within the selected execution environment; and responsive to failing to locate a compatible execution environment, issuing a user detectable alert," which goes to this concrete, tangible result. That is, it is a result of claim 1 to execute an application on a data processing system within a selected execution environment that has been selected because it is compatible, instead of doing what is done in the prior art, which is to execute an application in the first execution environment that is encountered, i.e., an application that may or not be compatible. The improved certainty of execution provided by the inventive arrangement of claim 1 is clearly a useful, concrete and tangible result. Likewise, claim 1 states that the method includes issuing a user detectable alert if a *compatible* execution environment has not been located. This is a further useful, concrete and tangible result. Claims 8 and 17 have similar language.

In addition, claims 1 and 8 are herein amended to recite "generating a user detectable alert," as suggested by Primary Examiner Mizrahi.

Claims 17-20

Claims 17-20 also stand rejected under 35 U.S.C. 101 on grounds that the claims are directed to non-statutory subject matter. Applicant respectfully disagrees for the same reasons set out above regarding claims 1-16. Applicant also amends claim 17, as described above regarding claims 1 and 8.

Claims 17-20 further stand rejected under 35 U.S.C. 101 on grounds that claims directed to "computer usable medium" are not proper. The Office action suggests "computer usable medium" are more properly stated as "computer readable storage medium." Applicant herein amends claim 17 responsively. (Claims 18-20 are dependent on claim 17.) Applicant also herein amends claims 17-20 to replace "code means" with "instructions," which is more consistent with the preamble of claim 17.

Rejections based on prior art

Claims 1, 8 and 17

Claims 1, 8 and 17 stand rejected under 35 U.S.C. 102(e) as being anticipated by Applicant Admitted Prior Art. The Office action cites Applicant's specification, pages 1-3. Applicant respectfully traverses.

Applicant wishes to thank Primary Examiner Mizrahi for conducting a telephone interview about the Office action with Attorney England on October 5, 2006. Following the remarks below regarding the written Office action are remarks addressing the matters discussed in the telephone interview.

The Office action merely recites claim 1 and flatly states that Applicant teaches this in Applicant's specification somewhere within pages 1-3, with no further explanation. Applicant submits that this does not constitute a proper and complete examination of the present application. That is, if a reference relied upon for the rejection (in this case, Applicant's own specification) is complex and describes matter including inventions other than that claimed by Applicant, the Office Action must explain the specific parts of the reference relied upon for rejection of each specific element or step of each claim and the pertinence of the specific parts. 37 CFR 1.104 (c)(2); MPEP 707.

In the present case, Applicant's own specification is complex and does describe matter including inventions other than that claimed by Applicant, particularly in pages 1-3. Further, by merely pointing at pages 1-3 of Applicant's specification the Office action does not explain the specific parts of the reference relied upon for rejection of each specific element or step and the pertinence of the specific parts for each of the claims in the present application. Applicant contends that such rejection is improper and respectfully requests that if the claims are not allowed, then the next Office action should be non-final and should properly set out the specific parts of the reference relied upon for the rejection and with explanation of the *pertinence of the specific parts*.

Given the nature of the rejection, Applicant is unable to determine what specific teaching in Applicant's specification the Office action considers to anticipate each element, step or limitation of each claim. A first step of claim 1, for example, states that a method includes "retrieving information indicative of a set of compatible execution environments, wherein each such compatible execution environment is suitable for executing the application." Based on the Office action alone, Applicant is unable to properly respond in order to distinguish this step from the alleged teaching of the prior art, beyond pointing out that pages 1-3 of Applicant's specification does not teach this and that elsewhere in Applicant's specification an embodiment illustrating this step is elaborated upon. In particular, JAR manifest file 212 is depicted in FIG. 5 of Applicant's specification, which states that file 212 includes some conventional aspects and some new aspects. Present application, page 6, lines 25-29. The present application goes on to explain the new aspects, including how they define information indicative of a set of compatible execution environments, and that this information is retrieved, i.e., "extracted," by parser 208 of FIG. 4. Present application, page 7, line 13 - page 8, line 10. Furthermore, the present application goes on in claim 5 to even more specifically state that "said retrieving information comprises retrieving a list of compatible JREs from a manifest of a Java.® archive (JAR) file associated with the application."

Another first step of claim 1 states that the method includes "responsive to locating at least one compatible execution environment installed on the system, selecting a compatible execution environment from the located execution environments and executing the application within the selected execution environment." Pages 1-3 of Applicant's specification do not teach

this. This is different than executing within the first JRE found by proceeding through directories specified in a PATH variable, as of Applicant's specification describes at page 3, lines 21-23, regarding the prior art. Elsewhere in Applicant's specification an embodiment illustrating the claimed step is elaborated upon. See, e.g., page 8, line 11 - page 9, line 2.

Since claims 8 and 17 have language similar to claim 1, according to the forms of the invention they respectively claim, the above arguments apply also to claims 8 and 17. Note also, in particular, pages 1-3 of Applicant's specification do not describe a file parser nor a search engine that receives information from the file parser, as stated in claim 8.

In the telephone interview of October 5, 2006, Attorney England pointed out to Primary Examiner Mizrahi the passage recited above from the present application, page 3, lines 19-31, which describes how an application will execute within the first JRE that it finds among specified directories regardless of compatibility, and describes how the application will fail to execute as intended if the first-found JRE is incompatible, even though a compatible JRE may exist in another directory. Attorney England further pointed out how this differs from "retrieving information indicative of a set of *compatible* execution environments, wherein each such *compatible* execution environment is suitable for executing the application," as claimed (emphasis added).

Pursuant to the above discussion, Attorney England surmised that in construing claim 1 of the present application, for example, the Office action has not given due weight to the word "compatible," although the word is used repeatedly in the claim, and even qualified with a "wherein" clause. Primary Examiner Mizrahi also tentatively raised a new issue, expressing the view that the word "compatible" may be indefinite. Attorney England respectfully submits that due weight must be given to all words of the claims and respectfully disagrees with the assertion that "compatible" is indefinite.

The present specification states that if an application attempts to execute on a JRE that is not compatible "the application will *fail to execute* as intended" (emphasis added). Present application, page 3, lines 24-25. This clearly indicates that a "compatible execution environment," as claimed for an application, means the application *will execute* in the environment. This is also consistent with a leading dictionary definition of "compatible," which is "able to exist or be used together without problems or conflict." Concise Oxford English

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Dictionary, 11th Edition, 2004, Oxford University Press. Indeed, claim 1 itself states a meaning of compatible that is consistent, i.e., "wherein each such compatible execution environment is *suitable for executing the application*" (emphasis added). Applicant submits, therefore, that the term "compatible" as used in the claims is clear and definite. Applicant further submits that if due weight is given to the term "compatible" in the claims, and if the clause "wherein each such compatible execution environment is suitable for executing the application" is given due weight, the claims are patentably distinct.

Claims 2-6, 9-16, and 18-20

In the prior art rejection, the Office action does not even mention claims 2-6, claims 9-16, or claims 18-20. Since the Office action does not assert that any prior art teaches what is claimed in claims 2-6, claims 9-16, and claims 18-20, and since these claims are not properly rejected on grounds of non-statutory subject matter, or else have been amended herein to overcome the non-statutory subject matter rejections as explained herein above, Applicant submits that the claims are allowable. In addition, Applicant submits the claims are allowable because they depend on allowable claims 1, 8 and 17, as explained herein above.

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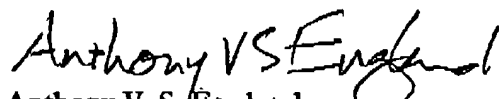   Filed: 10/30/2003

PRIOR ART OF RECORD

Applicant has reviewed the prior art of record cited by but not relied upon by Examiner, and asserts that the invention is patentably distinct.

REQUESTED ACTIONS

For the reasons explained herein above, Applicant contends that the claims herein are patentably distinct, and hereby requests that Examiner grant allowance and prompt passage of the application to issuance.

Applicant also respectfully requests that if the amended claims are not allowed a new, non-final Office Action be issued properly setting out an explanation of the specific parts and the pertinence of the specific parts of the reference relied upon for the rejection.

Respectfully submitted,

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